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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/344,010      | 06/25/1999  | STEVEN JEROME MOORE  | 122995-43-34        | 8566             |

7590

02/27/2002

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EXAMINER

TAYLOR, LARRY D

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 02/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/344,010

Applicant(s)

MOORE, STEVEN JEROME

Examiner

Larry D Taylor

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 June 1999.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Receipt of Pre-Amendment*

1. Receipt is acknowledged of the pre-amendment filed 25 June 1999.

### *Claim Objections*

2. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 48-67 have been renumbered 8-27. Claims 8 and 26 objected to because of the following informalities:

**Claim 8, line 1** – Change “the” to -- an --.

**Claim 8, lines 5, 8, and 16** – Change “the” to -- a --.

**Claim 26, line 8** – Change first occurrence of “the” to -- a --.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Art Unit: 2876

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claim 22-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Scroogie et al. (US 5,970,469).

Scroogie teaches a computer-assisted method of purchase, whereas a purchaser uses an identity card to purchase a good. The card would contain information, possibly pointing to an email address of the customer. When an identifier on the good is scanned by a scanner (col. 11, lines 60-62), the good is correlated with the customer in a database. Secondary purveyors, such as retailers or supermarkets are able to access the characteristics of the goods and offer discounts, coupons, or services based on the goods purchased by the customer. Such offers would provide an address as to where to used these discounts or services. These purchases and offers would be available via Internet. (see figures 13-15, col. 3, lines 14-38, col. 4, lines 34-40, col. 12, lines 8-42, col.12, line 64 – col. 13, line 9).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 26-27 are rejected under 35 U.S.C. 102(b) as being anticipate by Fahner et al. (US 4,822, 973).

Fahner teaches a method for encoding concealed identifiers on an item, the method

Art Unit: 2876

includes directing electromagnetic laser beams from laser 10 to a molten plastic material 14 on a part, the beams forming a unique identifier (see figures 3 and 4 and col. 4, lines 24-29)

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 8-11 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roach et al. (US 5,434,394) in view of Collier (US 5,646,365).

Roach teaches a computer assisted method of recording the identity of a purchaser at a retail setting. A customer selects a good to purchase and scans a bar code 68 on the good with scanner 18 or at POS terminal 16, the bar code known to identify the type of good, as well as its manufacturer. An operator at the terminal 16 accepts from the customer an optically encoded identity card 66. A card reader in the terminal reads the card in tandem with the bar code on the good, the information being correlated into a database to be shared by a computer headquarters or other retail systems (see figure 1 and col. 6, lines 28+). A sales receipt can be printed out by the terminal to reflect the purchase. In addition, the customer may also wish for the good to be delivered to his/her address. A telecommunications network ring 34 provides a means of digitally sending information relating to the good, purchaser, and delivery instructions to and from a headquarters network 8 or to a warehouse 40 (see figures 1 and 2, col. 3, line 27 – col. 4, line 6, col. 5, lines 8-17).

Art Unit: 2876

However, it is not specified that the good is enclosed within a package, the package having a bar code, which is correlatable with the good's bar code and is instead scanned at the time of purchase.

Collier teaches the purchasing of gun bullets, the bullets having a bar-coded good identifier therein under an outer surface of the bullet. The good identifier reflects the type of bullet, the lot, and manufacturer of the bullet. At the time of purchase, a customer would provide proper identification, to be cataloged with a bar code read from the package containing the bullets. This information would be held within a national computer database. The bar code on the package would correlate with the bar code in the bullet (see figures 1 and 2, and col. 3, lines 45-64). Collier reiterates that it is well known in the art of retail to scan both a good and the good's package in tandem with the identity of a purchaser. Such an act provides efficient inventory tracking as to what items are present within a package, and in the realm of gun/ammunition purchasing, allows secure and monitored purchasing of regulated items. Thus, it would have been obvious to one of ordinary skill in the art to provide such good/package identification.

10. Claims 12 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roach et al. as modified by Collier, further in view of Berson (US 5,768,384). The teachings of Roach as modified by Collier have been discussed above.

However, it is not taught that the good identifier is invisible to visible light. Such a step in manufacturing is well known in the art, as Berson teaches an affixed bar code for identifying an article, the bar code invisible to the unaided eye (see col. 3, lines 17-23). A sensor 53 and encryptor 43 would aid in verifying the article's authenticity. It would have been obvious to one of ordinary skill to employ this well-known tactic, as it prevents an unauthorized person from

Art Unit: 2876

readily viewing pertinent data regarding an item, which could lead to improper tampering or duplication of that data.

11. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roach et al. as modified by Collier, further in view of Lane (US 5,623,552). The teachings of Roach as modified by Collier have been discussed above.

However, it is not taught that the card is smart card, with the ability to be self-authenticating.

Lane teaches a smart card, that can be used at a plurality of locations, the card containing a microprocessor and means for self authentication and identification of a card holder (see figures 1 and 2, col. 1, lines 16-28).

This card is primarily used for the identification of a cardholder at the time of purchasing a good or service. It would have been obvious to one of ordinary skill in the art to provide such a card, as the smart card processor allows more data to be stored within the memory of the card and the authentication means allows the cardholder to verify identity without extensive assistance from a retail terminal and/or the terminal's operator. When purchasing goods at a retail terminal, as customer would enjoy the ability to identify his or herself in an expeditious manner, as the self-authenticating card would provide.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure – Kelly, Jr. (US 5,793,030), Liff et al. (US 5,713,485), and Sullivan et al. (US 5,992,742).

Art Unit: 2876

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Larry D Taylor whose telephone number is (703) 306-5867. The examiner can normally be reached on M-F (8:30 - 5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-4784 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Larry D Taylor  
February 25, 2002



**THIEN M. LE**  
**PRIMARY EXAMINER**